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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|-------------------------|---------------------|------------------|
| 09/938,497 | 08/27/2001 | Maria K. Boden Wastfelt | 012889-086 | 3731 |

21839 7590 03/27/2003

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EXAMINER

LANDSMAN, ROBERT S

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1647

DATE MAILED: 03/27/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/938,497

Applicant(s)

BODEN WASTFELT ET AL.

Examiner

Robert Landsman

Art Unit

1647

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-7 and 9-13 is/are pending in the application.
- 4a) Of the above claim(s) 2-7, 10 and 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9, 12 and 13 is/are rejected.
- 7) ☒ Claim(s) 9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. Formal Matters

A. Claims 1-11 were pending in this application and were subject to restriction in Paper No. 6, dated 12/18/02. In Paper No. 7, filed 1/21/03, Applicants elected Group I, claims 1, 8 and 9 with traverse. Applicants cancelled claims 1 and 8 and added new claims 12 and 13. Therefore, claims 2-7 and 9-13 are currently pending and claims 9, 12 and 13, which correspond to Group I, will be examined. Applicants argue that Groups III and IV should be recombined with elected Group I since there is no serious search burden on the Examiner and that the subject matter overlaps. This argument has been considered. At this time, the method claims will be separated from the protein claims for the reasons already of record on pages 2-3 of the Office Action dated 12/18/02. However, if the protein claims are found to be allowable, then the method claims may be rejoined if they are commensurate in scope with the protein claims and do not raise any issues under 35 USC 112. Therefore, this restriction is deemed proper and is, therefore, made FINAL.

2. Oath/Declaration

A. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because: non-initialed and/or non-dated alterations have been made to the oath or declaration. See 37 CFR 1.52(c). These changes have been made to the Post Office Addresses of both inventors.

3. Claim Objections

A. The syntax of claim 9 can be improved by placing the word "a" at the beginning of the claim to recite "a pharmaceutical."

4. Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

A. Claims 9, 12 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Palma et al. (J. Biol. Chem. 273:13177-13181, 1998; on the IDS of Paper No. 5). The claims recite a fibrinogen binding protein derived from *S. aureus* which binds prothrombin and which has a molecular weight of 60 Kd and that produces fragments of 50, 45, 40 and 30 Kd when digested with V8 protease. The claims also recite pharmaceutical compositions comprising this protein. Palma et al. teach a 60 Kd fibrinogen binding protein from *S. aureus* which binds prothrombin (page 13177, left column of the Introduction). Palma et al. do not teach that this protein produces fragments of 50, 45, 40 and 30 Kd when digested with V8 protease. However, in absence of evidence to the contrary, it would be inherent in the structure of the protein that, since it has the same molecular weight, is from the same organism and has the same binding properties as that of the present invention, it would produce the claimed fragments as that claimed by the present invention. One of ordinary skill in the art would immediately envision this protein in a pharmaceutical composition, such as water, or buffers, such as those taught throughout the "Materials and Methods" section.

B. Claims 9, 12 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Boden et al. (Microbial Pathogenesis; on the IDS of Paper No. 5). The claims recite a fibrinogen binding protein derived from *S. aureus* which binds prothrombin and which has a molecular weight of 60 Kd and that produces fragments of 50, 45, 40 and 30 Kd when digested with V8 protease. The claims also recite pharmaceutical compositions comprising this protein. Boden et al. teach a 60 Kd fibrinogen binding protein from *S. aureus* which binds prothrombin (Abstract). Boden et al. do not teach that this protein produces fragments of 50, 45, 40 and 30 Kd when digested with V8 protease. However, in absence of evidence to the contrary, it would be inherent in the structure of the protein that, since it has the same molecular weight, is from the same organism and has the same binding properties as that of the present invention, it would produce the claimed fragments as that claimed by the present invention. One of ordinary skill in the art would immediately envision this protein in a pharmaceutical composition, such as water, or buffers, such as those taught throughout the "Materials and Methods" section.

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5. Conclusion

A. No claim is allowable.

Advisory information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Landsman whose telephone number is (703) 306-3407. The examiner can normally be reached on Monday - Friday from 8:00 AM to 5:00 PM (Eastern time) and alternate Fridays from 8:00 AM to 5:00 PM (Eastern time).

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Gary Kunz, can be reached on (703) 308-4623.

Official papers filed by fax should be directed to (703) 308-4242. Fax draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Robert Landsman, Ph.D.
Patent Examiner
Group 1600
March 26, 2003

